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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,627	10/15/2008	Laura L. Eggink	04-997-US	5094
20306	7590	03/01/2010		
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			EXAMINER	
300 S. WACKER DRIVE			HUFF, SHEELA JITENDRA	
32ND FLOOR				
CHICAGO, IL 60606			ART UNIT	PAPER NUMBER
			1643	
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			03/01/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,627	<b>Applicant(s)</b> EGGINK ET AL.	
	<b>Examiner</b> Sheela J. Huff	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

To have a general inventive concept under PCT rule 13.1, the inventions need to be linked by a special technical feature. The special technical feature recited in claim 1 is a combination of compound A and an antibody which inhibits a growth factor or receptor of a growth factor. In view of this Rubenfield et al US 6551795 reads on the claim. This reference discloses SEQ ID NO. 27024 wherein aa 311-320 are GSQRLSATAR which read on applicant's claim 1. Therefore the technical feature recited in claim 1 is not special. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, 12-14 drawn to polypeptide of formula I.

Group II, claim(s) 5-6 drawn to polypeptide of Formula 2.

Group III, claim(s) 7-8 drawn to polypeptide of Formula 3.

Group IV, claim(s) 9-11 drawn to polypeptide that competes with free GalNAc for binding to GalNAc-specific lectin.

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Group V, claim(s) 15-17 drawn to nucleic acid sequence that encodes the polypeptide of Group I.

Group VI, claim(s) 18-25 drawn to method for stimulating immune system by administering the polypeptide of Group I.

Group VII, claim(s) 26 drawn to a method of treating an infection by administering the polypeptide of Group I.

Group VIII, claim(s) 27 drawn to a method of treating a tumor by administering the polypeptide of Group I.

Group IX, claim(s) 28 drawn to a method of treating a bone disorder by administering the polypeptide of Group I.

Group X, claim(s) 29 drawn to a method for anti-angiogenic therapy by administering the polypeptide of Group I.

Group XI, claim(s) 30 drawn to a method of treating an immune suppressed disorder by administering the polypeptide of Group I.

Group XII, claim(s) 31 drawn to a method of treating pain by administering the polypeptide of Group I.

Group XIII, claim(s) 32 drawn to a method of vaccinating a subject by administering the polypeptide of Group I.

Group XIV, claim(s) 33-34 drawn to a method of identifying a GalNAc-polypeptide mimetic using polypeptides.

Group XV, claim(s) 35-37 drawn to method of identifying a GalNAc-polypeptide mimetic using compounds that compete the polypeptides.

**If applicant elects Group IV or XV, then applicant is required to elect a single polypeptide (ie single SEQ ID NO. ) for examination. This is not an election of species but a restriction requirement.**

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special

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technical features for the following reasons: As set forth above, in view of the teaching of Rubenfield et al the groups are not so linked as to form a single general concept under PCT Rule 13.1 because the technical feature of claim 1 is not special.

The products of Groups I-V different in structure and chemical compositions. For example, the products of Groups I-IV are composed of amino acid residues whereas the sequence of Group V is composed of nucleotides. While the products of Groups I-IV are composed of amino acid residues, they are composed of a unique composition of amino acids in a unique order.

The methods of Inventions VI-XV differ in the method objectives, method steps and parameters and in the reagents used. Each method has a different end result. For example, the method of Group VI stimulates an immune response whereas the methods of the other groups do not. The method of Group VII treats an infection whereas the methods of the other groups do not. The same reasoning is applicable to Groups VIII-XIII. The methods of Groups XIV and XV result in identifying compounds but each method uses different methods steps/reagents. The examination of all groups would require different searches in the U.S. PATENT SHOES and the scientific literature and would require the consideration of different patentability issues. Thus Inventions II and III are separate and distinct in having different method objectives, method steps and parameters and in the reagents used and are patentably distinct.

Inventions I-III and VI-XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the polypeptide of Group I can be used in a materially different method such as those of Groups VI-XV and in affinity purification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different searches in the patent literature, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected

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process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Monday-Thursday 6am to 2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheela J Huff/  
Primary Examiner  
Art Unit 1643

sjh